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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,803	07/27/1999	MITSUHIRO KUNIEDA	35.G2440	5976

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NEW YORK, NY 10112

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/361,803

Applicant(s)

KUNIEDA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in US Patent Application Publication 2004/0214101 in view of Organic Photoreceptors for Imaging Systems to Borsenberger, pp. 6-19, 181, 182 & 203-211, and further in view of JP 01-84265, or Kawamorita *et al.* in US Patent 5,202,214, or Kovacs in US Patent 5,373,313.

These rejections were presented in the last Office action. Applicants' traversal centers on the limitation of the exposure means comprises a semiconductor laser having an oscillating wavelength of 380 to 450 nm while the transmittance of the charge transport layer is at least 90 %. Applicants do not appear to specifically disagree that the claimed limitations are found in the prior art or would have been obvious. If the Examiner's understanding is incorrect applicants are asked to clarify in the next response. Applicants do traverse, however, because the evidence of record in the instant application shows, in applicant's opinion, an unexpected result for the claimed apparatus, and also because there is not sufficient motivation to combine the references as asserted in the rejection.

Applicants take the position that the transmittance presented in the previous response was for the charge transport layer of Suzuki's example 1 not just the charge transport material. This position is noted but because the evidence is not in the form of a Rule 132 declaration the evidence is not probative. The Examiner notes that any declaration will be considered anew because no declaration is of record, either in executed or unexecuted form. The remarks in the

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last response also do not state that the transmittance was for the layer rather than the compound.

Further, and as noted in the last Office action, applicants have not provided sufficient reasons why the Comparative Example 1, which uses a hydrazone with a transmittance of 0 % at 380 nm and about 20 % at 445 nm, is an appropriate comparison to show an unexpected and non-obvious result for stability and durability as compared to the prior art. It is not apparent that the hydrazone is as close as or closer to the claimed invention than the amino-stilbene compound used by Suzuki. When applicants use a comparative example different from the applied art's example it is incumbent on applicant to explain why the different example was used. Applicants have not explained why they chose to use a hydrazone as the charge transport material rather than the actual material of Suzuki in Suzuki's photoreceptor, which appears to be able to be reproduced noting the transmittance tests discussed in the remarks. Applicants continue to rely on the teaching in Suzuki that there is equivalence for the triarylamines, stilbene, and hydrazone charge transport compounds. Although each of these compounds is effective as a charge transport material, applicants have not advanced any reason why these compounds are equivalent in charge transport function and durability, which is discussed in the specification and applicants' response.

With respect to Borsenberger and the combination rejection, applicants are correct that Borsenberger teaches a variety of arylamine charge transport compounds and do not recognize the compounds as obtaining the results desired for the instant invention. However, Borsenberger discloses the specifically disclosed compounds, such as tri-p-tolylamine or triphenylamine. The fact that Suzuki teaches triarylamines combined with the teaching in Borsenberger that arylamines, such as tri-p-tolylamine and triphenylamine, are exceedingly well known in the art and well studied would provide ample motivation for the artisan to arrive at the

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claimed invention. The artisan would have been expected to use such well known compounds for their known function. This is not the situation where the hole transport compounds are unusual or obscure. Arylamines, such as tri-p-tolylamine and triphenylamine, are exceedingly well known, as shown by the Borsenberger text. The use of such well known materials for their known function when that function is called upon by the primary reference provides sufficient motivation for the artisan to arrive at the claimed invention.

There is a reasonable expectation of success to obtain a working photoreceptor combining the references given the detailed instructions on how to make and use Suzuki's photoreceptor combined with the teaching in Borsenberger that specific arylamines are exceedingly well known and effective for the purposes of charge transport. Suzuki also teaches arylamines as effective in that invention. The weight of the evidence is such that the claimed invention is obvious to one of ordinary skill.

Applicants are referred to the remarks presented throughout prosecution and, particularly, in the last Office action for the reasons that the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr
23 August 2006


CHRISTOPHER RODEE
PRIMARY EXAMINER